

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
Thomas Daley)	
Application No: 10/767,649)	Art Unit: 3696
Filed: January 29, 2004)	Confirmation No.: 5572
For: SYSTEMS AND METHODS FOR)	Examiner: Gerald C. Vizvary
MATCHING TRADING ORDERS)	
)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTERVIEW SUMMARY

Applicants' representatives, Ruth Ma and Dean Alderucci, wish to thank Examiner Gerald Vizvary and his supervisor Examiner Thomas Dixon, for their time and courtesy for conducting a telephone interview on June 11, 2009 with regards to the Notice of Non-Compliant Amendment that was mailed on March 30, 2009 for Application No. 10/767,649.

A. RESTRICTION REQUIREMENT

As part of that discussion, Examiner Vizvary conceded that the Notice of Non-Compliant Amendment was improperly issued, since Applicants did not file any amendments in their response to the Restriction Requirement of December 17, 2008. Examiner Vizvary has agreed to withdraw the Notice of Non-Compliant Amendment.

The parties also discussed the Restriction Requirement of December 17, 2008, in which Examiner Vizvary restricted method claims **18-34** from their analogous apparatus counterparts, claims **69-85**. Applicants' representatives asserted that method claims **18-**

34 should be grouped together with the analogous apparatus claims **69-85**, at least because there was no showing of “a serious burden on the examiner” and no showing that the claims were “independent or distinct” per MPEP 803(I).

Examiner Vizvary stated that he considers an infringement test as the basis for determining whether restriction would be proper. In other words, the Examiner asserted that restriction between claims would be proper if one claim could be infringed without infringing the other claim. Examiner Vizvary thus argued that since apparatus claims **69-85** could be infringed (e.g., by selling the apparatus to another party) without infringing the method claim to which it refers, the apparatus claims should be restricted from the method claims.

Applicants’ representatives agree that those apparatus claims could be infringed without infringing those method claims. That is why the apparatus claims do not depend from the method claims.

However, Applicants’ representatives disagreed that the infringement test suffices to show that restriction would be proper. If the infringement test did suffice, every independent claim would be restricted from every one of its dependent claims. In fact, if the infringement test did suffice, every claim would always be restricted from every other claim, since for any two claims, one of the claims can be infringed without infringing the other. Applicants’ representatives provided the Examiners with the example of an independent claim that is directed at a pencil and a dependent claim that is directed at a red pencil. In that case, a green pencil would infringe the independent claim (i.e. the pencil), but would not infringe the dependent claim (i.e., the red pencil). This simple example highlights the fallacy in using the infringement test for a restriction determination.

B. CLAIM FORMAT

Applicants’ representatives also discussed the format of claims **69-85**, which are written in simplified form by *referring* to a method claim—and not explicitly *repeating*

all of the recitations of the method claim—for the convenience of the Examiner and ultimately for the convenience of the public. If the recitations of the referenced method claims were copied into each of claims **69-85**, then during prosecution the Examiner would need to carefully review the amendments to the method language in both claims to verify consistency or identify differences.

Applicants' representatives explained that claims **69-85** are written in a format similar to product-by-process claims, which are permissible under the Manual of Patent Examining Procedure (MPEP). Examiner Dixon stated that he was not familiar with product-by-process claims. Applicants' representatives agreed to provide the Examiners with relevant portions of the MPEP that relate to product-by-process claims.

Specifically, § 2173.05(p) of the MPEP states the following:

There are many situations where claims are permissively drafted to ***include a reference to more than one statutory class of invention***... A product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper. [citations omitted]... A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used, without being objectionable under 35 U.S.C. § 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process.

Applicants' representative reiterated that the language of claims **69-85** makes it clear that each of the claims recite an apparatus. In fact, each claim begin by reciting an “apparatus” and contain a clear reference to only the claimed “apparatus,” so there is no confusion that it might be a method claim or anything other than an apparatus claim.

The claims also recite two structural elements of the apparatus: a processor and a memory. The memory stores instructions that can direct the processor to perform the steps of the referenced method claim. In fact, nothing at all in the claim has been shown to make the claim unclear. The mere reference in a product claim to a process does not itself render a claim unclear.

In Scripps Clinic & Research Foundation v. Genentech, 927 F.2d 1565 (Fed. Cir. 1991), the court references referential product-by-process claims of U.S. Reissue Patent No. 32,011. For example, claim 13 recites:

13. Highly purified and concentrated human or porcine VIII:C prepared in accordance with the method of claim 1.

The parties agreed to defer further discussion of the claims in order to allow the Examiners to have an opportunity to review and understand product-by-process claims.

Applicants' undersigned attorney can be reached at the address shown below. All communications should be directed to the undersigned at her direct line (857) 413-2056 or e-mail address: rma@cantor.com.

Respectfully submitted,

Date: June 12, 2009

Customer No:

Innovation Group
Cantor Fitzgerald, LP
110 E. 59th Street
New York, NY 10022

_____/Ruth J. Ma/_____
Ruth J. Ma, Reg. No. 55,414
Attorney for Applicant
Tel. No. (857) 413-2056
Fax. No. (857) 413-2019